

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CUSTOMER NO. 22927

Appellants: Jay S. Walker, James A. Jorasch, Russell Sammon, Stephen
Tulley, and Steven Santisi
Application No.: 10/685,143
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Title: A METHOD AND APPARATUS FOR OUTPUTTING A
MESSAGE AT A GAMING MACHINE

Attorney Docket No.: 02-040

Group Art Unit: 3714
Examiner: Leiva, Frank M.

APPEAL BRIEF

**BOARD OF PATENT APPEALS
AND INTERFERENCES**

Mail Stop: Appeal Brief
Commissioner for Patents
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Appellants hereby appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner in the Final Office Action mailed December 18, 2006 (Part of Paper No./Mail Date 20061204), rejecting claims **1-6, 21-26, 36-40, 55 and 56**. This Appeal Brief is filed subsequent to a Notice of Appeal filed June 18, 2007.

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REAL PARTY IN INTEREST

The present application is assigned to Walker Digital, LLC, Two High Ridge Park, Stamford, CT 06905.

RELATED APPEALS AND INTERFERENCES

No interferences or appeals are known to Appellants, Appellants' legal representative, or assignee that will directly affect, be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims **7-20, 27-35, and 41-54** were previously cancelled.

Claims **1-6, 21-26, 36-40 and 55-56** are pending in the present application and are rejected.

Claims **1-6, 21-26, 36-40 and 55-56** are being appealed.

STATUS OF AMENDMENTS

No amendments were filed subsequent to the Final Office Action mailed December 18, 2006, the rejections of which are being appealed herein.

SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of the independent claims being appealed, and the dependent claims being specifically argued, are provided below. The summaries include sufficient information about the claimed subject matter so that an informed review of the Examiner's adverse determination of patentability can be made.

As required by 37 C.F.R. § 41.37(c)(1)(v), reference is made to the Specification and Drawings, as appropriate. Any such reference:

- (i) is by way of example of the claimed subject matter only;
- (ii) is to be considered as potentially useful in clarifying the particular subject matter of the particular independent claim being explained (and not other claims or "the invention" as a whole), unless explicitly stated otherwise; and
- (iii) is not to be considered as broadening or narrowing the scope of any recited term from its meaning to one of ordinary skill in the art, unless explicitly stated otherwise.

Of the claims being appealed, claims **1, 21, 36, 38, 40 and 55** are independent, and dependent claims **2-6, 22-26, 37, 39 and 56** are specifically argued.

1. Independent Claim 1

In accordance with one or more embodiments, a method comprises *determining a message*. See, for example, Specification, pg. 38, lines 9-10; Fig. 17.

The method further provides for *identifying a game machine*. See, for example, Specification, pg. 16, line 30-page 17, line 2.

The method further provides for *determining gaming activity associated with a player*. See, for example, Specification, pg. 7, lines 5-6.

The method further provides for *determining a feature of the game machine, the feature being selected based on the gaming activity*. See, for example, Specification, pg. 7, lines 11-12; page 8, lines 10-11.

The method further provides for *wherein the feature comprises a feature that may be activated based on a selection by the player*. See, for example, Specification, pg. 44, lines 10-11.

The method further provides for *outputting the message to a player via the game machine, the message comprising a recommendation of the feature*. See, for example, Specification, pg. 120, lines 25-26; Fig. 17.

2. Independent Claim 21

In accordance with one or more embodiments, a method comprises *determining a message*. See, for example, Specification, pg. 38, lines 9-10; Fig. 17.

The method further provides for *determining a gaming activity of a player*. See, for example, Specification, pg. 7, lines 5-6.

The method further provides for *determining a feature of the game machine, the feature being selected based on the gaming activity*. See, for example, Specification, pg. 7, lines 11-12; page 8, lines 10-11.

The method further provides for *wherein the feature comprises a feature that may be activated based on a selection by the player*. See, for example, Specification, pg. 44, lines 10-11.

The method further provides for *outputting the message to a player via the game machine, the message comprising a recommendation of the feature*. See, for example, Specification, pg. 120, lines 25-26; Fig. 17.

3. Independent Claim 36

In accordance with one or more embodiments, a method comprises *determining a message*. See, for example, Specification, pg. 38, lines 9-10; Fig. 17.

The method further provides for *determining a first representation of the message and a second representation of the message*. See, for example, Specification, pg. 70, line 1-page 73, line 2.

The method further provides for *outputting the first representation of the message to a first player at a game machine*. See, for example, Specification, pg. 70, lines 4-5.

The method further provides for *outputting the second representation of the message to a second player at a game machine*. See, for example, Specification, pg. 70, lines 4-5.

The method further provides for *wherein determining the first representation includes selecting a representation based upon a characteristic of the first player*. See, for example, Specification, pg. 71, line 31-page 72, line 7.

The method further provides for *wherein determining the second representation includes selecting a representation based upon a characteristic of the second player*. See, for example, Specification, pg. 71, line 31-page 72, line 7.

4. Independent Claim 38

In accordance with one or more embodiments, a method comprises *determining a message*. See, for example, Specification, pg. 38, lines 9-10; Fig. 17.

The method further provides for *determining a first representation of the message and a second representation of the message*. See, for example, Specification, pg. 70, line 1-page 73, line 2.

The method further provides for *outputting the first representation of the message to a first player at a game machine*. See, for example, Specification, pg. 70, lines 4-5.

The method further provides for *outputting the second representation of the message to a second player at a game machine*. See, for example, Specification, pg. 70, lines 4-5.

The method further provides for *wherein determining the first representation includes selecting a representation based upon an indication by the first player*. See, for example, Specification, pg. 84, line 1.

The method further provides for *wherein determining the second representation includes selecting a representation based upon an indication by the second player*. See, for example, Specification, pg. 84, line 1.

5. Independent Claim 40

In accordance with one or more embodiments, a method comprises *determining a message to be output to a player at a game machine*. See, for example, Specification, pg. 38, lines 9-10; Fig. 17.

The method further provides for *suppressing output of the message*. See, for example, Specification, pg. 7, lines 15-16, page 17, lines 6-8.

The method further provides for *wherein suppressing output of the message includes delaying output of the message until a trigger condition is satisfied*. See, for example, Specification, pg. 20, lines 30-31.

6. Independent Claim 55

In accordance with one or more embodiments, a method comprises *determining an occurrence of a trigger condition*. See, for example, Specification, pg. 7, lines 1-10.

The method further provides for *identifying a message in a database of messages based on the trigger condition*. See, for example, Specification, pg. 33, line 21-pg. 34, line 2; Figs. 11A and 11B.

The method further provides for *identifying a game machine from among a plurality of game machines based on the message*. See, for example, Specification, pg. 107, line 29-pg. 108, line 6.

The method further provides for *suppressing output of the message until a second trigger condition is satisfied*. See, for example, Specification, pg. 116, lines 15-18.

The method further provides for *displaying the identified message in a partition on the identified game machine upon satisfaction of the second trigger condition*. See, for example, Specification, pg. 70, line 24.

The method further provides for *wherein the partition is a pop-up window*. See, for example, Specification, pg. 70, line 24.

The method further provides for *wherein the identified message includes a feature recommendation*. See, for example, Specification, pg. 120, lines 25-26, Fig. 17.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims **1-6, 21-26, 36-40 and 55-56** stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,942,574 to LeMay et al. (“LeMay” herein).

ARGUMENTS

1. Form of Appeal Brief

In the arguments herein, limitations of the claims are indicated in *italics*, claim numbers are indicated in **bold**, and the references of record are indicated by underlining.

In separate arguments of patentability of different Groups of claims, Appellants have, where possible, referred to prior arguments to avoid undue repetition.

In the arguments below, Appellants may refer to:

The Final Office Action, which is the office action the rejections of which are being appealed herein, which was mailed on December 18, 2006 as part of Paper No./Mail Date 20061204; and

The Response to the First Office Action, which was mailed by Appellants on April 23, 2007.

2. 35 U.S.C. §102(e) Rejections

Claims **1–6, 21–26, 36–40, 55 and 56** stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,942,574 to LeMay et al. ("LeMay" herein). Appellants respectfully traverse the rejection of these claims based on the reasons presented below.

The Examiner's Section 102(e) rejections based on the above grounds are argued separately for the following appealed claims and groups of appealed claims:

- Claim **1**;
- Claim **21**;
- Claims **36, 37, 38 and 39**;
- Claim **40**;
- Claim **55**;
- Claim **56**;
- Claims **2, 3, 4, 5 and 6**;
- Claims **22, 23, 24, 25 and 26**.

2.1. Claim 1

Appellant respectfully assert that the Examiner has failed to show how the limitations of claim **1** are taught or otherwise suggested by LeMay. It is well settled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Appellants respectfully assert that claim **1** recites the following limitation that is not taught or suggested by LeMay:

- *outputting a message to a player via the game machine, the message comprising a recommendation of the feature [of the game machine]*

The Examiner asserted that “Regarding Claim 1: determining a message (Abstract, Figures 4-6, Column 1, lines 7-11, Column 2, lines 15-29, Column 2, line 55-Column 3, line 3, Column 3, lines 7-60, Column 4, lines 44-57, 64-67, Column 5, lines 8-12, 21-58, Column 6, lines 19-30, Column 7, lines 1-18, 26-40, Column 7, line 55-Column 8, line 21, Column 8, lines 33-44, Column 8, line 58-Column 9, line 10, Column 9, lines 26-31, 60-67, Column 10, lines 28-35, Column 11, line 15-Column 12, line 49, Column 13, lines 45-67, and Column 14, lines 1-21_; 5. Identifying a game machine (Id.); 6. Determining gaming activity associated with a player (Id.); 7. Determining a feature of the game machine, the feature being selected based on the gaming activity, wherein the feature that may be activated based on a selection by the player (Id.); and 8. Outputting the message to a player via the game machine, the message comprising a recommendation of the feature (Id.).” (Final Office Action, pages 2-3).

Appellants respectfully assert that LeMay, in all of the sections cited by the Examiner in support of the rejection of independent claim **1** and in the remainder, merely describes providing *access* to particular content or content source based on certain information (e.g., a player identifier). However, LeMay is completely devoid of any description of *recommending* a feature of a gaming device.

Providing access to content or a content source by making it available to a player is different from recommending content or a content source, much less from recommending a feature of a game machine.

It is clear that recommending the feature is distinct from merely outputting a message. LeMay, at most, can be characterized as outputting a message (e.g., by outputting an indication of content or sources that the player has access to). But LeMay does not address recommending content or a content source, much less recommending a feature and does not enable how such a recommendation may be determined or accomplished.

In the Response to Arguments section of the Final Office Action, the Examiner asserted:

28. In regards to the argument of claims 1, 21, and 55 rejections, the teaching for outputting a message to a player via the game and the message comprising a recommendation of the feature. (See Abstract). The abstract shows a player receiving a personal messages, “that is of particular interest to the player utilizing the gaming machine”, such would be the list of features available to the player.

Appellants respectfully assert that the Examiner is in error when characterizing the teachings of LeMay. The relevant portion of the Abstract, to which the Examiner refers, recites, in its entirety:

In addition, the player utilizing the gaming machine may receive personal messages on the gaming machine. For example, while utilizing the gaming machine, a player may receive, e-mail, stock

quotes, news and advertising that is of particular interest to the player utilizing the gaming machine.

As is evident, LeMay teaches numerous forms of personal messages including e-mail, stock quotes, news, and advertising. As is also evident, contrary to the Examiner's assertion, none of these personal messages is disclosed to be a "list of features available to the player." A detailed examination of LeMay, including an electronic search, reveals only two unique references to a list, specifically, a "list of one or more entertainment content sources" and a "content list 265 of entertainment content sources". It is therefore evident that the "list" to which the Examiner refers is not a list at all, but rather one or more personal messages. Further, to the extent that LeMay discloses any list, it is a list of content sources, not features of the gaming machine as claimed.

Appellants note that claim 1 recites, in part, outputting a message comprising a recommendation of a feature of the game machine, **the feature being selected based on the gaming activity**. It is therefore further evident that assuming, arguendo, that the personal messages of LeMay comprise "features available to the player", there is no teaching or suggestion that such messages include a **recommendation of a feature of the game machine** or that such **features are selected based on the gaming activity** as claimed.

For all of these reasons, it is clear that LeMay fails to teach or otherwise suggest *outputting a message to a player via the game machine, the message comprising a recommendation of the feature [of the game machine]* as recited in claim 1. As a result, the rejection of Claim 1 must be withdrawn.

2.2. Claim 21

Appellant respectfully assert that the Examiner has failed to show how the limitations of claim **21** are taught or otherwise suggested by LeMay. It is well settled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Appellants respectfully assert that claim **21** recites the following limitation that is not taught or suggested by LeMay:

- *outputting the message to the player via the game machine, the message comprising a recommendation of the feature [of the game machine]*

The Examiner asserted that "Regarding Claim 21: determining a message (id.); determining a gaming activity of a player (Id.); and outputting the message to the player via the game machine based on the gaming activity of the player (Id.)." (Final Office Action, page 3).

Appellants respectfully assert that LeMay, in all of the sections cited by the Examiner in support of the rejection of independent claim **21** and in the remainder, merely describes providing *access* to particular content or content source based on certain information (e.g., a player identifier). However, LeMay is completely devoid of any description of *recommending* a feature of a gaming device. Providing access to content or a content source by making it available to a player is

different from recommending content or a content source, much less from recommending a feature of a game machine.

It is clear that recommending the feature is distinct from merely outputting a message. LeMay, at most, can be characterized as outputting a message (e.g., by outputting an indication of content or sources that the player has access to). But LeMay does not address recommending content or a content source, much less recommending a feature and does not enable how such a recommendation may be determined or accomplished.

In the Response to Arguments section of the Final Office Action, the Examiner asserted:

28. In regards to the argument of claims 1, 21, and 55 rejections, the teaching for outputting a message to a player via the game and the message comprising a recommendation of the feature. (See Abstract). The abstract shows a player receiving a personal messages, “that is of particular interest to the player utilizing the gaming machine”, such would be the list of features available to the player.

Appellants respectfully assert that the Examiner is in error when characterizing the teachings of LeMay. The relevant portion of the Abstract, to which the Examiner refers, recites, in its entirety:

In addition, the player utilizing the gaming machine may receive personal messages on the gaming machine. For example, while utilizing the gaming machine, a player may receive, e-mail, stock

quotes, news and advertising that is of particular interest to the player utilizing the gaming machine.

As is evident, LeMay teaches numerous forms of personal messages including e-mail, stock quotes, news, and advertising. As is also evident, contrary to the Examiner's assertion, none of these personal messages is disclosed to be a "list of features available to the player." A detailed examination of LeMay, including an electronic search, reveals only two unique references to a list, specifically, a "list of one or more entertainment content sources" and a "content list 265 of entertainment content sources". It is therefore evident that the "list" to which the Examiner refers is not a list at all, but rather one or more personal messages. Further, to the extent that LeMay discloses any list, it is a list of content sources, not features of the gaming machine as claimed.

Appellants note that claim 21 recites, in part, outputting a message comprising a recommendation of a feature of the game machine, **the feature being selected based on the gaming activity**. It is therefore further evident that assuming, arguendo, that the personal messages of LeMay comprise "features available to the player", there is no teaching or suggestion that such messages include a **recommendation of a feature of the game machine** or that such **features are selected based on the gaming activity** as claimed.

For all of these reasons, it is clear that LeMay fails to teach or otherwise suggest *outputting a message to a player via the game machine, the message comprising a recommendation of the feature [of the game machine]* as recited in claim 21. As a result, the rejection of Claim 21 must be withdrawn.

2.3 Claims 36, 37, 38 and 39

Appellants respectfully assert that the Examiner has failed to show how the limitations of claims **36** and **38** are taught or otherwise suggested by LeMay. It is well settled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Appellants respectfully assert that claims **36 and 38** recite the following limitations that are not taught or suggested by LeMay:

- *determining a first representation of the message and a second representation of the message;*
- *outputting the first representation of the message to a first player at a game machine;*
- *outputting the second representation of the message to a second player at a game machine;*

The Examiner relied entirely upon previous citations when asserting that LeMay teaches the elements of claims **36 and 38**.

Appellants assert that claims **36 and 38** clearly recite that the same message is output via two representations, one representation being output to a first player and a second representation of the same message being output to a second player. LeMay fails to describe such a feature. In LeMay, if messages are output to two

different players, the messages may be different for the two different players (e.g., a first message may be output to a first player and a second message may be output to a second player) but there is no description in LeMay of determining the same single message and outputting two different representations of the single message to two respective players. For example, if a menu of available content is output to two different players, the menu output to the first player may list content different from the menu output to the second player. However, this is two different messages, not two different representations of the same message.

In the Response to Arguments section (Final Office Action, page 6), the Examiner asserted:

30. In regards to the arguments to claims 36 and 38 rejections, determining multiple massaging for multiple players can be summarize in the abstract where it says “a player may receive, e-mail, stock quotes, news, and advertising”, the examiner deems that these forms of messages have to be different and unique to a player for the exception of news, constituting a first message and a second message and outputted accordingly.

Appellants respectfully assert that the Examiner is in error when characterizing the teachings of LeMay. Appellants further assert that the Examiner is incorrect when characterizing the elements of claims **36 and 38**.

First, contrary to the Examiners assertion, there is no teaching or suggestion that the “forms of messages have to be different and unique to a player”. Simply put, LeMay teaches, at most, that personal messages can be output to a player. There is no teaching of any other player and no teaching that, were there to be

another player to whom a message was output, such a hypothetical message would differ from the disclosed personal messages.

Second, contrary to the Examiner's assertion, claims **36 and 38** do not recite a player receiving two different messages. Rather, as noted above, claims **36 and 38** recite outputting **the same message via two representations**, one representation being output **to a first player** and a second representation of the same message being output **to a second player**. It is therefore evident that LeMay does not teach or otherwise suggest *determining a first representation of the message and a second representation of the message, outputting the first representation of the message to a first player at a game machine, and outputting the second representation of the message to a second player at a game machine* as recited in claim **36 and 38**.

Appellants further assert that LeMay does not teach or otherwise suggest the following element of claim **36**:

- *wherein determining the first representation includes selecting a representation based upon a characteristic of the first player, and wherein determining the second representation includes selecting a representation based upon a characteristic of the second player.*

Appellants merely assert that, as LeMay does not teach or otherwise suggest *determining a first representation of the message and a second representation of the message*, it logically follows that LeMay does not further teach or suggest *wherein determining the first representation includes selecting a representation based upon a characteristic of the first player, and wherein determining the second*

representation includes selecting a representation based upon a characteristic of the second player as recited in claim 36.

Appellants further assert that LeMay does not teach or otherwise suggest the following element of claim 38:

- *wherein determining the first representation includes selecting a representation based upon an indication by the first player, and wherein determining the second representation includes selecting a representation based upon an indication by the second player.*

Appellants merely assert that, as LeMay does not teach or otherwise suggest *determining a first representation of the message and a second representation of the message*, it logically follows that LeMay does not further teach or suggest *wherein determining the first representation includes selecting a representation based upon an indication by the first player, and wherein determining the second representation includes selecting a representation based upon an indication by the second player* as recited in claim 38.

For all of these reasons, the rejections of claims 36 and 38 must be withdrawn.

Appellants further note that the Examiner asserted that “Regarding Claim 37: wherein the first representation is different from the second representation (Id.).” (Final Office Action, page 4).

Appellants merely note that claim 37 depends upon claim 36 and includes all of the limitations of claim 36. For this reason alone, the rejection of claim 37 must be withdrawn. In addition, Applicants assert that, as LeMay does not disclose a first and second representation of a message, it is axiomatic that LeMay does not

teach or otherwise disclose *wherein the first representation is different from the second representation* as recited in claim 37. For this additional reason, the rejection of claim 37 must be withdrawn.

Appellants further note that the Examiner asserted that "Regarding Claim 39: wherein the first representation is different from the second representation (Id.)." (Final Office Action, page 5).

Appellants merely note that claim 39 depends upon claim 38 and includes all of the limitations of claim 38. For this reason alone, the rejection of claim 38 must be withdrawn. In addition, Applicants assert that, as LeMay does not disclose a first and second representation of a message, it is axiomatic that LeMay does not teach or otherwise disclose *wherein the first representation is different from the second representation* as recited in claim 39. For this additional reason, the rejection of claim 39 must be withdrawn.

2.4 Claim 40

Appellant respectfully assert that the Examiner has failed to show how the limitations of claim 40 are taught or otherwise suggested by LeMay. It is well settled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent claim 40 recites the following limitation that is not taught or suggested by LeMay:

- *suppressing output of the message, wherein suppressing output of the message includes delaying output of the message until a trigger condition is satisfied*

Appellants have reviewed the entirety of LeMay and have been unable to find any description of suppressing a message from being output after the message has been determined, much less suppressing it by delaying the output of the message until a trigger condition is satisfied.

In the Response to Arguments section (Final Office Action, page 6), the Examiner asserted:

31. In regards to the argument to claims 40 and 55 rejection, “suppressing output of the message” the examiner understands that inherently all messages are pre-created and held, kept, delayed or suppressed until time of transmittal or delivery. (Col 11:56 – Col 12:5).

Appellants allow that LeMay teaches, generally, at the above citation, creating a message and sending the message to a gaming machine. However, Appellants respectfully assert that the Examiner is incorrect when characterizing the nature of messages. Assuming, arguendo, that a single clock tick of a processor, typically on the order of a fraction of a billionth of a second, passes between determining a message and outputting the message, such a passage of time might amount to holding or keeping the output of the message. However, in each such instance, the passage of time is an inherent characteristic of the sequence by which a message is

determined and outputted and involves no affirmative action to delay the outputting of the message.

In contrast, *suppressing* a message requires an affirmative action to prevent the outputting of a message. Appellants therefore respectfully assert that the Examiner is in error when asserting that “inherently all messages are pre-created and held, kept, delayed or **suppressed** until time of transmittal or delivery”. (emphasis added). It is most emphatically not the case that messages are **inherently suppressed** until a time at which they are transmitted. In addition, claim **40** does not merely recite that the output of the message is suppressed. Rather, claim **40** recites that suppressing the output of the message *includes delaying output of the message until a trigger condition is satisfied*. It is further most emphatically not the case that messages are inherently suppressed until a trigger condition is satisfied. For all of these reasons, the rejection of claim **40** must be withdrawn.

2.5 **Claim 55**

Appellant respectfully assert that the Examiner has failed to show how the limitations of claim **55** are taught or otherwise suggested by LeMay. It is well settled that “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent claim **55** recites the following limitation that is not taught or suggested by LeMay:

- *suppressing output of the message until a second trigger condition is satisfied.*

Appellants have reviewed the entirety of LeMay and have been unable to find any description of suppressing a message from being output after the message has been determined, much less suppressing it by delaying the output of the message until a trigger condition is satisfied.

In the Response to Arguments section (Final Office Action, page 6), the Examiner asserted:

32. In regards to the argument to claims 40 and 55 rejection, “suppressing output of the message” the examiner understands that inherently all messages are pre-created and held, kept, delayed or suppressed until time of transmittal or delivery. (Col 11:56 – Col 12:5).

Appellants allow that LeMay teaches, generally, at the above citation, creating a message and sending the message to a gaming machine. However, Appellants respectfully assert that the Examiner is incorrect when characterizing the nature of messages. Assuming, arguendo, that a single clock tick of a processor, typically on the order of a fraction of a billionth of a second, passes between determining a message and outputting the message, such a passage of time would amount to holding, keeping, or delaying the output of the message. However, in each such instance, the passage of time is an inherent characteristic of the sequence by which a message is determined and outputted and involves no affirmative action to delay the outputting of the message.

In contrast, *suppressing* a message requires an affirmative action to prevent the outputting of a message. Appellants therefore respectfully assert that the Examiner is in error when asserting that “inherently all messages are pre-created and held, kept, delayed or **suppressed** until time of transmittal or delivery”. (emphasis added). It is most emphatically not the case that messages are **inherently suppressed** until a time at which they are transmitted. In addition, claim 55 does not merely recite that the output of the message is suppressed. Rather, claim 55 recites that suppressing the output of the message *until a second trigger condition is satisfied*. It is further most emphatically not the case that messages are inherently suppressed until a trigger condition is satisfied. For all of these reasons, the rejection of claim 55 must be withdrawn.

2.6 **Claim 56**

Appellant respectfully assert that the Examiner has failed to show how the limitations of claim 56 are taught or otherwise suggested by LeMay. It is well settled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Dependent claim 56 recites the following claim limitation that is not taught or suggested by LeMay:

- *data indicating how a result of the gaming activity would have been different if the recommended feature had been activated during the gaming activity.*

The Examiner asserted that “Regarding Claim 56: data indicating how a result of the gaming activity would have been different if the recommended feature had been activated during the gaming activity (Id.).” (Final Office Action, page 6).

Appellants respectfully assert that LeMay is, in fact, completely devoid of any description of outputting a message that includes data indicating how a result of gaming activity would have been different if the recommended feature had been activated during the gaming activity. In fact, LeMay is completely devoid of any description of a feature that may affect the result of gaming activity if it is activated.

In the Response to Arguments section, the Examiner asserted:

33. In regards to the argument to claim 56 rejection, “data indicating how a result would have been different if the feature had been activated”, would be considered gambling training as such are the marketing videos in most gambling hotel resorts. These marketing messages would be available to the player in LeMay et al as described in the abstract.

Appellants respectfully assert that the Examiner’s reference to gambling training videos is insufficient to allow the Appellant’s to respond effectively and, furthermore, that the reference fails to teach or suggest all of the elements of claim 56.

First, contrary to the Examiner’s assertion, there is nowhere stated in the abstract of LeMay the availability of marketing messages. Second, even if there

were disclosed marketing videos, there is no teaching or suggestion by LeMay, nor an assertion by the Examiner, that such marketing videos would indicate *how a result of the gaming activity would have been different if the recommended feature had been activated during the gaming activity*. As a result, the Examiner has failed to establish a *prima facie* case for the rejection of claim 56. As a result, the rejection of claim 56 must be withdrawn.

2.7 Claims 2, 3, 4, 5 and 6

Appellant respectfully assert that the Examiner has failed to show how the limitations of claims 2, 3, 4, 5 and 6 are taught or otherwise suggested by LeMay. It is well settled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Dependent claims 2, 3, 4, 5 and 6 recite the following claim limitations that are not taught or suggested by LeMay:

- *wherein determining the message includes determining a status message.* (claim 2);
- *wherein determining the message includes determining an instructive message.* (claim 3);
- *wherein determining the message includes determining a communication message.* (claim 4);
- *wherein determining the message includes determining a promotional message.* (claim 5);

- *wherein determining the message includes determining an activity-benefit offer.* (claim 6).

The Examiner asserted that “regarding claim 2: wherein determining the message includes determining a status message. (Id.). 10. Regarding claim 3: wherein determining the message includes determining an instructive message. (Id.). 11. Regarding claim 4: wherein determining the message includes determining a communication message. (Id.). 12. Regarding claim 5: wherein determining the message includes determining a promotional message. (Id.). 13. Regarding claim 6: wherein determining the message includes determining an activity-benefit offer. (Id.).” (Final Office Action, page 3).

Appellants note that, as all of claims **2-6** depend upon claim **1** and include all of the limitations and elements of claim **1**, for the reasons discussed above in section 2.1 with regards to claim **1**, the rejections of all of claims **2-6** must be withdrawn.

Furthermore, Appellants assert that the Examiner has failed to establish a *prima facie* case for anticipation of claims **2-6**. Specifically, the Examiner’s blanket assertion of “Id.” does not establish by evidence, let alone substantial evidence, a teaching by LeMay of the elements of claims **2-6**. As has already been established in section 2.1, LeMay does not teach or suggest *outputting a message to a player via the game machine, the message comprising a recommendation of the feature* as recited in claim **1**. It is therefore axiomatic that, as LeMay does not teach outputting such a message, LeMay does not teach outputting such a message having an additional attribute.

Quite simply, Appellants assert that LeMay does not teach or suggest a message *comprising a recommendation of the feature [of the game machine]*

wherein the message additionally and alternatively includes a status message, an instructive message, a communication message, a promotional message, and an activity-benefit offer as recited in claim **2, 3, 4, 5 and 6**, respectively.

For these additional reasons, the rejections of all of claims **2-6** must be withdrawn.

2.8 **Claims 22, 23, 24, 25 and 26**

Appellant respectfully assert that the Examiner has failed to show how the limitations of claims **22, 23, 24, 25 and 26** are taught or otherwise suggested by LeMay. It is well settled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Dependent claims **22, 23, 24, 25 and 26** recite the following claim limitations that are not taught or suggested by LeMay:

- *wherein determining the message includes determining a status message.* (claim **22**);
- *wherein determining the message includes determining an instructive message.* (claim **23**);
- *wherein determining the message includes determining a communication message.* (claim **24**);
- *wherein determining the message includes determining a promotional message.* (claim **25**);
- *wherein determining the message includes determining an activity-benefit offer.* (claim **26**).

The Examiner asserted that “regarding claim 22: wherein determining the message includes determining a status message. (Id.). 16. Regarding claim 23: wherein determining the message includes determining an instructive message. (Id.). 17. Regarding claim 24: wherein determining the message includes determining a communication message. (Id.). 18. Regarding claim 25: wherein determining the message includes determining a promotional message. (Id.). 19. Regarding claim 26: wherein determining the message includes determining an activity-benefit offer. (Id.).” (Final Office Action, page 4).

Appellants note that, as all of claims **22-26** depend upon claim **21** and include all of the limitations and elements of claim 1, for the reasons discussed above in section 2.2 with regards to claim **21**, the rejections of all of claims **22-26** must be withdrawn.

Furthermore, Appellants assert that the Examiner has failed to establish a *prima facie* case for anticipation of claims **22-26**. Specifically, the Examiner’s blanket assertion of “Id.” does not establish by evidence, let alone substantial evidence, a teaching by LeMay of the elements of claims **22-26**. As has already been established in section 2.2, LeMay does not teach or suggest *outputting the message to the player via the game machine, the message comprising a recommendation of the feature* as recited in claim **21**. It is therefore axiomatic that, as LeMay does not teach outputting such a message, LeMay does not teach outputting such a message having an additional attribute.

Quite simply, Appellants assert that LeMay does not teach or suggest a message *comprising a recommendation of the feature [of the game machine]* wherein the message additionally and alternatively includes a status message, an

instructive message, a communication message, a promotional message, and an activity-benefit offer as recited in claim **22, 23, 24, 25 and 26**, respectively.

For these additional reasons, the rejections of all of claims **22-26** must be withdrawn.

CONCLUSION

Thus, the Examiner's rejections of the pending claims are improper at least because the Examiner has not provided a proper legal basis for rejecting any claim. Therefore, Appellants respectfully request that the Examiner's rejections be withdrawn.

If any issues remain, or if there are any further suggestions for expediting allowance of the present application, please contact Jeffrey R. Ambroziak, at telephone number 203-461-7317 or via electronic mail at jambroziak@walkerdigital.com.

Appellants believe that this Appeal Brief is filed within one month of the statutory time within which to respond. Accordingly, filed herewith is a petition for a one month extension of time as well as the attendant fees. However, if an additional fee should be due, please charge such fees to our Deposit Account No. 50-0271.

September 18, 2007
Date

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APPENDIX A - CLAIMS INVOLVED IN THE APPEAL

1. A method, comprising:
determining a message;
identifying a game machine;
determining gaming activity associated with a player;
determining a feature of the game machine, the feature being selected based on the gaming activity,
wherein the feature comprises a feature that may be activated based on a selection by the player; and
outputting the message to a player via the game machine, the message comprising a recommendation of the feature.
2. The method of claim 1 wherein determining the message includes determining a status message.
3. The method of claim 1 wherein determining the message includes determining an instructive message.
4. The method of claim 1 wherein determining the message includes determining a communication message.
5. The method of claim 1 wherein determining the message includes determining a promotional message.

6. The method of claim 1 wherein determining the message includes determining an activity-benefit offer.

21. A method, comprising:
determining a message;
determining a gaming activity of a player;
determining a feature of a game machine, the feature being selected based on the gaming activity,
wherein the feature comprises a feature that may be activated based on a selection by the player; and
outputting the message to the player via the game machine, the message comprising a recommendation of the feature.

22. The method of claim 21 wherein determining the message includes determining a status message.

23. The method of claim 21 wherein determining the message includes determining an instructive message.

24. The method of claim 21 wherein determining the message includes determining a communication message.

25. The method of claim 21 wherein determining the message includes determining a promotional message.

26. The method of claim 21 wherein determining the message includes determining an activity-benefit offer.

36. A method, comprising:
determining a message;
determining a first representation of the message and a second representation of the message;
outputting the first representation of the message to a first player at a game machine; and
outputting the second representation of the message to a second player at a game machine;
wherein determining the first representation includes selecting a representation based upon a characteristic of the first player, and
wherein determining the second representation includes selecting a representation based upon a characteristic of the second player.

37. The method of claim 36 wherein the first representation is different from the second representation.

38. A method, comprising:
determining a message;
determining a first representation of the message and a second representation of the message;
outputting the first representation of the message to a first player at a game machine; and

outputting the second representation of the message to a second player at a game machine;

wherein determining the first representation includes selecting a representation based upon an indication by the first player, and

wherein determining the second representation includes selecting a representation based upon an indication by the second player.

39. The method of claim 38 wherein the first representation is different from the second representation.

40. A method, comprising:

determining a message to be output to a player at a game machine; and
suppressing output of the message,

wherein suppressing output of the message includes delaying output of the message until a trigger condition is satisfied.

55. A method, comprising:

determining an occurrence of a trigger condition;

identifying a message in a database of messages based on the trigger condition;

identifying a game machine from among a plurality of game machines based on the message;

suppressing output of the message until a second trigger condition is satisfied; and

displaying the identified message in a partition on the identified game machine upon satisfaction of the second trigger condition,

wherein the partition is a pop-up window, and
wherein the identified message includes a feature recommendation.

56. The method of claim 1, wherein the message further comprises:
data indicating how a result of the gaming activity would have been different
if the recommended feature had been activated during the gaming activity.

APPENDIX B – EVIDENCE

<NONE>

APPENDIX C – RELATED PROCEEDINGS

<NONE>